



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,874	12/22/1999	MARC MEHRZAD JALISI	ACS-58267 (1700X)	6721
24201	7590	11/16/2006	EXAMINER	
FULWIDER PATTON 6060 CENTER DRIVE 10TH FLOOR LOS ANGELES, CA 90045			MACNEILL, ELIZABETH	
			ART UNIT	PAPER NUMBER
			3767	

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/470,874

Applicant(s)

JALISI ET AL

Examiner

Elizabeth R. MacNeill

Art Unit

3767

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15, 17 and 19-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17 and 19-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is in response to applicant's amendments submitted 3 October 2006, in view of the Pre-Brief Appeal Conference decision made 15 June 2006.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-15, 17, and 19-29 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over THOME et al (US 5,776,080) in view of FAGAN et al (WO 96/25969, cited by applicant).

Regarding claims 1, Thome teaches a heat-treated elongate member comprising a composite core (150), the composite core section including an inner core (154) formed of a precipitation hardened material (stainless steel, see WO 96/25969 for disclosure of precipitation hardened stainless steel for use in a medical guidewire) and a layer formed of a superelastic material (178, Nitinol), wherein the layer is arranged about the inner core (See Fig 25) (Col 16 lines 54-end).

Regarding claim 8, Examiner takes the "flexible body overlying the distal section" to be the superelastic layer (178). Thome teaches the precipitation hardenable material to be Hiberco 50B, which contains cobalt and iron (and trace elements), and Fagan discloses

Art Unit: 3767

an alloy of nickel, cobalt, molybdenum and chromium (MP35N, page 17 lines 19) (also applicable to claims 10,13,14,15).

Regarding claim 26, Thome further discloses a flexible coil (162, 182) disposed at a distal end of the guidewire, wherein the precipitation hardened material and superelastic material extend from the proximal section to at least through a part of a length of the flexible coil.

Regarding claim 27, Thome further discloses that the distal section is tapered (Fig 27)

Regarding claims 2-4, the modulus of elasticity of the composite elongate is about  $28 \times 10^6$  to  $29 \times 10^6$  (Fagan page 17 line 23).

Regarding claims 5-7, the ultimate tensile strength of the composite elongate is 300 k.s.i. (Fagan page 17 line 26).

Regarding claim 9, the composite core is precipitation hardenable stainless steel (Fagan)

Regarding claim 17, the inner core and outer layer are independently formed (Thome)

Regarding claim 19, the first layer is Nitinol (Thome)

Regarding claims 20,21,28,,29 a second layer (158) is disposed at least in part concentrically about the first layer, second layer of substantially the same material as the first layer (Thome)

Regarding claims 22,24, the elongate member is a guidewire (Thome)

Regarding claims 11 and 12, Thome discloses the claimed invention except for the use of less than 1% nickel precipitation hardened stainless steel. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use

nickel free stainless steel, since it has been held to be within the general skill of worker in the art to select a known material on the basis of its suitability for the intended use a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1--15,17, and 19-29 have been considered but are moot in view of the new ground(s) of rejection.

4.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth R. MacNeill whose telephone number is (571)-272-9970. The examiner can normally be reached on 7:00-3:30pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571)272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ERM

*Elyse H. Martin*  
11/8/06

KEVIN C. SIRMONS  
SUPERVISORY PATENT EXAMINER

*Kevin C. Sirmons*